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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

MAYES, MELVIN C

ART UNIT PAPER NUMBER

1734

DATE MAILED: 09/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/826,616

Applicant(s)

WEDER ET AL.

Examiner

Melvin Curtis Mayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/16/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

(1)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

(2)

Claim 6 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for cutting the roll of material to provide a sheet of material after applying adhesive, does not reasonably provide enablement for cutting the roll of material to provide a sheet of material before applying the adhesive. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

According to the specification, a roll of material is passed by an adhesive applicator then subsequently the material is cut into a sheet of material for wrapping about a floral grouping or pot. The specification is not enabling for cutting the roll of material into a sheet before passing by an adhesive applicator.

(3)

Claims 7-9 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for covering the outer surface and bottom of a flower pot, does not reasonably provide enablement for covering only a portion of the outer surface or bottom, as encompassed by "at least a portion of" an outer surface or bottom or leaving the bottom

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uncovered. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The specification and figures describe and show wrapping a flower pot such that the outer surface and bottom of the pot are covered. The specification does not describe wrapping with covering only a portion of the outer surface or bottom of the flower pot or with leaving the bottom uncovered. Leaving the bottom uncovered is only shown for a floral grouping, not for a flower pot. Claims 7-9 should be cancelled.

(4)

Claims 11-30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the pot cover having bonding material disposed on at least a portion of its inner surface when placing the pot into the interior space thereof, does not reasonably provide enablement for bonding material disposed on the outer surface of the pot cover. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

While the specification discloses bonding material on the inner surface of a pot cover and bonding material on the exterior surface of a flower pot, the specification does not disclose bonding material on the outer surface of a pot cover. Reference to "outer" surface in Claim 11 should be cancelled and Claims 20 and 22 should be cancelled.

(5)

Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described

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in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not describe a pot cover having an open bottom. The claim should be cancelled

(6)

Claim 24 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification does not describe bonding material disposed on at least a portion of the inner surface of a pot. The claims should be cancelled.

(7)

Claim 29 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for pot cover preformed to fit a pot having a specific size and shape, does not reasonably provide enablement for pot cover preformed to fit pots having different sizes and shapes. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The specification does not describe a pot cover preformed to fit pots having different sizes and shapes but only describes a pot cover preformed to fit a pot of specific size and shape.

Double Patenting

(8)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(9)

Claims 1-5 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of U.S. Patent No. 5,459,976.

Although the conflicting claims are not identical, they are not patentably distinct from each other because:

US 5,459,976 claims a method for wrapping a floral grouping comprising: providing a sheet of material having upper and lower surfaces; passing at least a portion of the sheet by an adhesive strip applicator comprising a housing and means for causing a portion of adhesive transfer tape to contact the sheet; placing the floral grouping on the sheet and wrapping the sheet about the floral grouping, the passing and wrapping in a continuous process.

(10)

Claims 11, 14, 15, 17, 21, 23 and 26-28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 6, 8 and 9 of U.S.

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Patent No. 5,820,712. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

US 5,820,712 claims a method for covering a flower pot comprising: providing a preshaped pot cover having an upper end, outer surface, inner surface, interior space and base and having an adhesive or cohesive bonding material disposed upon at least one of the inner surface and inner bottom surface, pot cover preshaped to conform to a pot having specific size and shape; providing a pot; placing the pot into the interior space of the pot cover; and bondingly connecting via the bonding material securing the pot cover about the pot; wherein the pot has bonding material upon a portion of its outer surface or the pot cover further comprises a skirt or the bonding material on the pot cover has a release strip which is removed.

(11)

Claim 30 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,820,712 in view of FR 2 610 604.

U.S. Patent No. 5,820,712 does not claim that the pot cover is formed of a material selected from a group including polymer film.

FR 2 610 604 teaches that for covering a flower or plant container such as a pot, a film of non-porous and water-resistant plastic material is formed into a three-dimensional object corresponding to an outer shape of a container used for growing flowers or plants (Abstract).

It would have been obvious to one of ordinary skill in the art to have modified the method of U.S. Patent No. 5,820,712 by providing the pot cover of polymer film, as taught by

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FR '604, as non-porous and water-resistant material used to form a covering for flower or pot containers.

(12)

Claims 11-17, 19, 21, 23, 27 and 28 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 6, 8 and 9 of U.S. Patent No. 6,533,886. Although the conflicting claims are not identical, they are not patentably distinct from each other because:

US 5,820,712 claims a method for covering a flower pot comprising: providing a preformed pot cover having an inner surface, bottom surface and opening and having an adhesive strip disposed upon at least a portion of the inner surface; providing a pot; placing the pot into the opening of the pot cover; and bondingly connecting via the bonding material securing the pot cover about the pot; wherein the pot has bonding material upon a portion of its outer surface or the pot cover further comprises a skirt extending from the upper end of the pot cover or the bonding material on the pot cover has a release strip which is removed.

By providing a preformed pot having a bottom surface and an opening into which the pot is placed, the pot cover has a base, an interior space, an outer peripheral surface and an outer bottom surface as claimed.

Claim Rejections - 35 USC § 103

(13)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

(14)

Claims 11-17, 19, 21, 24 and 26-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2 610 604 in view of Crawford 3,962,503.

FR 2 610 604 discloses a method of covering a flower or plant container such as a pot, planter or similar object comprising: forming a sheet of decorated and moisture resistant plastic material into a three-dimensional object corresponding to an outer shape of a container used for growing flowers or plants, the object having edges bent outward to form a continuous lip which extends beyond the top of the pot (skirt); and applying the formed object to the outside of the container (Abstract and oral translation). FR '604 does not disclose providing the formed object with a bonding material upon a portion of at least one of its inner and outer surfaces.

Crawford teaches that to provide a decorative, moisture retaining device for a floral container such as a pot which will adhere to the container thereby facilitating the handling of the containers without the protective device becoming disarranged, spaced pressure sensitive adhesive spots are provided to adhere the device to the lower face of the pot or container so as to maintain the pot in fixed relation with respect to the tray and sheet of material of the device. The adhesive is provided with treated paper covering to prevent sticking to undesired objects until it is desired to assemble with a pot (col. 1, lines 5-63, col. 3, lines 5-20).

It would have been obvious to one of ordinary skill in the art to have modified the method of FR '604 for covering a flower or plant container such as a pot with a decorated and moisture resistant plastic cover formed into a shape corresponding to the outer shape of the pot by providing the formed object with adhesive spots on its inner surface, as taught by Crawford, to adhere the cover to the lower face of the pot so as to maintain the pot in fixed relation with

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respect to decorative and moisture retaining cover and facilitate the handling of the pot without the cover becoming disarranged. Providing the adhesive spots with release material disposed thereon such as treated paper for removing, as claimed in Claim 17, would have been obvious to one of ordinary skill in the art, as taught by Crawford, to prevent sticking of the adhesive to undesired objects until it is desired to assemble with a pot.

Conclusion

(15)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 571-272-1234.

The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Melvin Curtis Mayes
Primary Examiner
Art Unit 1734

MCM

September 15, 2004